

### **REMARKS**

The Office Action mailed May 30, 2003 has been carefully reviewed. In view of the following remarks, Applicants respectfully request withdrawal of all outstanding rejections and urge that the interference be declared.

#### ***Formal Matters***

The pending Office Action requests a copy of a letter from Applicants regarding references, apparently filed on February 5, 1998. Respectfully, Applicants have no record of such a letter being filed on or about this date and request clarification. Applicants have filed two Information Disclosure Statements in this application, one on July 15, 1996 (Certificate of Deposit on July 10, 1996) and another on September 25, 1998. Signed, initialed and dated copies of both of these IDS submissions have been returned to Applicants by the Office. Courtesy copies of the considered PTO Forms 1449 are included with this Response.

Copies of corrected formal drawings are filed herewith. Entry of these drawings is requested.

#### ***Suspension of Prosecution***

Applicants acknowledge, with appreciation, the indication that the suspension of prosecution mailed October 1, 2002 has been withdrawn.

#### ***Status of the Claims***

Claims 81-87 and 93-106 are pending.

#### ***The Rejection of Claims under 35 U.S.C. § 112 First Paragraph***

Applicants acknowledge, with appreciation, withdrawal of the rejection of claims 93-106 under 35 U.S.C. § 112, first paragraph.

***Request for Interference and Submission under 37 C.F.R. § 1.608(b)***

On April 3, 2001, Applicants filed a response to the Office Action mailed on October 3, 2000. With the response, Applicants filed a submission under 37 C.F.R. § 1.608(b) in the form of unexecuted declarations of Dr. Richard M. White and Mr. Scott A. Tapor. Also included were Exhibits A through Q in support.

On April 18, 2001, Applicants filed a supplemental submission under 37 C.F.R. § 1.608(b) in the form of executed declarations of Dr. Richard M. White and Mr. Scott A. Tapor. The declaration executed by Dr. White was inadvertently labeled "Declaration under 37 C.F.R. § 1.131."

On April 20, 2001, Applicants filed a supplemental submission under 37 C.F.R. § 1.608(b) in the form of an executed declaration by Mr. William J. Egan, III.

The presently pending Office Action indicates that the Declaration of Dr. Richard M. White, inadvertently labeled "Declaration under 37 C.F.R. § 1.131," is insufficient as a submission under 37 C.F.R. § 1.608(b). Accordingly, Applicants submit herewith an executed declaration by Dr. Richard M. White under 37 C.F.R. § 1.608(b). Said declaration is clearly labeled as a declaration under 37 C.F.R. § 1.608(b). In addition, Applicants submit concurrently herewith, copies of the previously filed declarations and Exhibits A through Q, all of which are filed and were filed under 37 C.F.R. § 1.608(b). Entry and consideration of these submissions is earnestly requested.

Applicants have been invited to make a showing under 37 CFR § 1.608(b). In response, Applicants state that they completed the invention prior to the effective filing date (*i.e.*, May 1, 1992) of the application on which US Pat. No. 5,498,392 issued. Submitted for the Examiner's consideration are executed declarations from one of the inventors, Prof. Richard M. White, as well as Mr. Scott A. Taper and Mr. William J. Egan, III who corroborate the inventors' acts.

Applicants completed conception of a device corresponding to the claims and due diligence was exercised until the device was reduced to practice. The invention was made in this country by Applicants prior to May 1, 1992. The declarations explain with particularity why Applicants are *prima facie* entitled to judgment that they are the first inventors.

Evidence relied upon by declarants is being submitted as Northrup Exhibits A to Q. Dates prior to May 1, 1992 on the exhibits have been redacted.

Declaration of an interference between this application and US Pat. No. 5,498,392 to Wilding *et al.* is earnestly solicited.

### ***The Rejections of Claims under 35 U.S.C. §§ 102 and 103***

Claims 81, 82, 87 and 93-106 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Wilding *et al.* (US Pat. No. 5,498,392). Applicants traverse, *inter alia*, because the Wilding *et al.* reference is not prior art.

Claims 81, 82, 86, 87 and 93-106 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Wilding *et al.* (US Pat. No. 5,498,392) taken in view of Hafeman *et al.* (Science 240: 1182, 1988). Applicants traverse, *inter alia*, because the Wilding *et al.* reference is not prior art.

As shown by the attached declarations and exhibits, US Pat. No. 5,498,392 to Wilding *et al.* is not prior art because Applicants completed the invention in this country prior to the effective filing date of the application on which the Wilding *et al.* patent issued.

Applicants respectfully request that the claim rejections made under 35 U.S.C. §§ 102 and 103 be withdrawn.

### ***Objections to the Claims***

Claims 83-85 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claim. In view of the foregoing, Applicants respectfully request withdrawal of the objection.

### ***Conclusion***

In view of the foregoing remarks, Applicants respectfully request withdrawal of all outstanding rejections and urge that the interference be declared. Should the Examiner believe

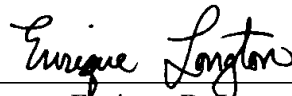
that a telephonic interview would expedite prosecution of this application, he is encouraged to contact the undersigned at his convenience.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No.50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

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**INDEX OF DECLARATIONS FILED UNDER 37 C.F.R. § 1.608(b)**

<b>Tab</b>	<b>Description</b>
1	Declaration of Dr. Richard M. White under 37 C.F.R. § 1.608(b)
2	Declaration of Mr. Scott A. Taper under 37 C.F.R. § 1.608(b)
3	Declaration of Mr. William J. Egan III under 37 C.F.R. § 1.608(b)

**INDEX OF EXHIBITS FILED UNDER 37 C.F.R. § 1.608(b)**

<b>Tabs</b>	<b>Description</b>
A-Q	Northrup Exhibits A through Q submitted under 37 C.F.R. § 1.608(b)